

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 41

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**



Ex parte MICHAEL J. SULLIVAN

Appeal No. 2004-1257  
Application No. 08/926,246<sup>1</sup>

ON BRIEF

Before GARRIS, NASE, and CRAWFORD, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 to 8, which are all of the claims pending in this application.

We AFFIRM.

<sup>1</sup> Filed September 5, 1997. According to the appellant (specification, p. 1), this application is a divisional of Application No. 08/714,661 filed September 16, 1996, which in turn is a divisional of Application No. 08/562,540, filed November 20, 1995, which is a continuation of Application No. 08/070,510, filed June 1, 1993.

BACKGROUND

The appellant's invention relates to a three piece solid golf ball. A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claim 1, the only independent claim on appeal, reads as follows:

A three piece solid golf ball comprising:  
a center core, an intermediate layer, and a cover enclosing the core  
through the intermediate layer;  
said center core having a diameter of at least 29 mm (1.1417 inches) and  
a specific gravity of less than 1.4;  
said intermediate layer having a thickness of at least 1 mm  
(0.03937 inches), a specific gravity of less than 1.2, and a hardness of at least  
85 on JIS C (Shore C) scale, the specific gravity of said intermediate layer being  
lower than the specific gravity of said center core; and  
said cover having a thickness of 1 to 3 mm (0.03937 to 0.1182 inches)  
and being softer than said intermediate layer.

The following two rejections are before us in this appeal:

- (1) Claims 1 to 8 under 35 U.S.C. § 112, first paragraph, as containing subject matter  
which was not described in the specification in such a way as to enable one skilled in  
the art to which it pertains, or with which it is most nearly connected, to make and/or  
use the invention; and
- (2) Claims 1 to 8 under 35 U.S.C. § 102(b) as being anticipated by European Patent  
Application No. 0 633 043 A1<sup>2</sup> to Higuchi et al. (Higuchi).

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<sup>2</sup> Published January 11, 1995.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 31, mailed November 4, 2002) and answer (Paper No. 37, mailed October 31, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 36, filed June 5, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied reference to Higuchi, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**Rejection (2)**

We sustain the rejection of claims 1 to 8 under 35 U.S.C. § 102(b) as being anticipated by Higuchi.

The sole issue raised by the appellant concerning the anticipation rejection is whether or not the claims under appeal are entitled to the benefit of the filing date of Application No. 08/070,510 (i.e., June 1, 1993) so as to remove the prior art status of

Higuchi. The appellant argues (brief, p. 17) that claims 1 to 8 are entitled to an effective filing date of June 1, 1993 and accordingly the reference to Higuchi is not prior art. The examiner maintains (answer, pp. 2-5) that the claims under appeal are only entitled to an effective filing date of September 5, 1997 (the date that Application No. 08/926,246 was filed copying claims 1 to 8 from U.S. Patent No. 5,553,852<sup>3</sup>) and therefore the reference to Higuchi is prior art.

We find that the effective filing date of the appealed claims 1 to 8 is September 5, 1997.

At the outset, we note, as indicated *supra*, that the appellant has denoted the present application as a **divisional**<sup>4</sup> of Application No. 08//714,661 filed September 16, 1996, which in turn is a **divisional** of Application No. 08/562,540, filed November 20, 1995, which is a **continuation** of Application No. 08/070,510, filed June 1, 1993.

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<sup>3</sup> Issued September 10, 1996 to Higuchi et al. This patent and the applied European Patent Application both claim benefit to the same Japanese patent application (193065, filed July 8, 1993).

<sup>4</sup> The present application is not a divisional application of Application No. 08/631,613 since no restriction under the provisions of 35 U.S.C. § 121 was made in Application No. 08/631,613. In our view, for reasons set forth *infra*, the present application is a continuation-in-part of Application No. 08/631,613 since the present application recites features which were not disclosed or adequately supported by a proper disclosure under 35 U.S.C. § 112 in Application No. 08/631,613, but which were first introduced in the present application.

Under certain circumstances an application for patent is entitled to the benefit of the filing date of a prior nonprovisional application. The conditions are specified in 35 U.S.C. § 120.<sup>5</sup>

There are four conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. Those conditions are:

- (1) The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or original nonprovisional application) and the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112<sup>6</sup>;
- (2) The second application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application;

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<sup>5</sup> 35 U.S.C. § 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. . . .

<sup>6</sup> The description and enablement requirements of 35 U.S.C. § 112, first paragraph, are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971).

- (3) The second application must contain a specific reference to the prior application(s) in the specification; and
- (4) The second application must be filed by an inventor or inventors named in the previously filed application.

We find that with respect to Application No. 08/714,661, Application No. 08/562,540 and Application No. 08/070,510 the appellant has satisfied conditions (2), (3) and (4) but condition (1) is not met. Accordingly, the appellant is not entitled to benefit of the filing date of Application No. 08/070,510 (i.e., June 1, 1993).

If a claim in an application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. § 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the application such a claim is entitled only to the filing date of the application. See Transco Products, Inc. v. Performance Contracting Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); In re Von Lagenhoven, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972) and Chromalloy American Corp. v. Alloy Surfaces Co., Inc., 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972).

In this case, it is clear that the subject matter of claims 1 to 8 lack written description support in Application No. 08/714,661, Application No. 08/562,540 and

Application No. 08/070,510.<sup>7</sup> Specifically, we fail to find written description support in Application No. 08/714,661, Application No. 08/562,540 and Application No. 08/070,510 for the following limitations recited in independent claim 1: (1) the center core having a diameter of at least 29 mm (1.1417 inches); (2) the center core having a specific gravity of less than 1.4; (3) the intermediate layer having a thickness of at least 1 mm (0.03937 inches); (4) the intermediate layer having a specific gravity of less than 1.2; (5) the intermediate layer having a hardness of at least 85 on JIS C (Shore C) scale; and (6) the cover having a thickness of 1 to 3 mm (0.03937 to 0.1182 inches).

Application No. 08/714,661, Application No. 08/562,540 and Application No. 08/070,510 do disclose (1) that the conventional solid core is about 1.545 inches in diameter, although it can range from about 1.495 to about 1.575 inches; (2) a center core having a specific gravity of 1.154; (3) that the intermediate layer can have a thickness from about 0.100 inches to about 0.010 inches, preferably about 0.0375 inches; (4) an intermediate layer having a thickness of about 0.0675 inches; (5) that the intermediate layer can have a specific gravity in the range of 0.920 to 0.990; (6) an intermediate layer having a hardness on JIS C (Shore C) scale in the range of 96 to 98; and (7) that the cover can have a thickness from about 0.010 inches to about 0.050

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<sup>7</sup> The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

inches in thickness, preferably 0.0300 inches. However, these different ranges and examples do not provide written description support for the now claimed ranges.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath. Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

We have reviewed the originally filed disclosure in Application No. 08/714,661, Application No. 08/562,540 and Application No. 08/070,510 and find no express disclosure for the above-noted limitations of claim 1. In addition to an express disclosure, the written description requirement can be satisfied by showing that the disclosed subject matter, when given its "necessary and only reasonable construction,"

inherently (i.e., necessarily) satisfies the limitation in question. See Kennecott Corp. v. Kyocera Int'l. Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). We find no inherent disclosure from our review of the originally filed disclosure in Application No. 08/714,661, Application No. 08/562,540 and Application No. 08/070,510 for the above-noted limitations of claim 1.<sup>8</sup> In that regard, we note that a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. See Tronzo v. Biomet Inc., 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Vas-Cath Inc., 935 F.2d at 1563-64, 19 USPQ2d at 1117; In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975); In re DiLeone, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971); In re Wohnsiedler, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963).

For the reasons set forth above, the appellant is not entitled to benefit of either the filing date of Application No. 08/714,661 (September 16, 1996), Application No. 08/562,540 (November 20, 1995) or Application No. 08/070,510 (June 1, 1993). Accordingly, Higuchi is prior art to the claims under appeal. Since the appellant has not

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<sup>8</sup> The appellant has not pointed out where the above-noted limitations of claim 1 find either express or inherent disclosure in Application No. 08/714,661, Application No. 08/562,540 or Application No. 08/070,510.

further argued the merits of this rejection, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 102(b) as being anticipated by Higuchi is affirmed.

**Rejection (1)**

We will not sustain the rejection of claims 1 to 8 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation.

See United States v. Telecommunications, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of

protection provided by a claim is not adequately enabled by the disclosure). Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide.

See *In re Brandstadter*, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973).

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application (i.e., September 10, 1997), would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth *supra* is to determine whether the examiner has met the initial burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

In our view, the present specification, coupled with information known in the art, clearly enables one skilled in this art to make and use, without undue experimentation, golf balls as recited in claims 1 to 8. In that regard, we note that both U.S. Patent No. 5,553,852 and the applied European Patent Application to Higuchi were known in that art as of the effective filing date of the appellant's application (i.e., September 5, 1997).

With that knowledge, one skilled in this art could make and use, without undue experimentation, golf balls as recited in claims 1 to 8.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 112, first paragraph, is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 102(b) is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley T. Harris

BRADLEY R. GARRIS  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

MURRIEL E. CRAWFORD  
Administrative Patent Judge

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